

Rejection of the claims under 35 U.S.C. § 103(a):

All the pending claims presently are rejected under 35 U.S.C. § 103 over the combination of U.S. Patent No. 6,729,797 B2 (“Manger”) in view of U.S. Patent No. 5,544,974 (“Berg”) and U.S. Patent No. 6,886,388 B1 (“McGill”). Applicants traverse the rejection.

Responding to applicants’ amendment filed December 8, 2005, the Examiner alleges:

With regard to Applicants’ statement that Manger et al. ‘797 fail to teach a monitoring liquid reservoir as recited in the claims, the Examiner contends that the term “fluid” encompasses both liquids and gases. Therefore, it would be within the scope of the patented device [i.e., the Manger device] to use a monitoring liquid. Furthermore, the Examiner notes that Applicant only positively recites a liquid in claim 10. As such, the reservoir (32) shown by Manger et al. ‘797 anticipates the recited “monitoring liquid reservoir” in the claims as set forth in the above Office action.

As an initial matter, applicants note that all the pending claims, not just claim 10, positively recite “a monitoring liquid reservoir in liquid communication with the annular space.” Further, the claims are presently rejected under 35 U.S.C. § 103 as allegedly obvious over Manger in view of Berg and McGill; therefore, the Examiner implicitly admits that Manger does not anticipate the claimed invention.

With regard to the rejection of the claims under 35 U.S.C. § 103, applicants understand that the Examiner alleges that the fluid monitoring reservoir of Manger could have held either liquids or gases and thus would have motivated the artisan of ordinary skill to use either as the monitoring fluid in the cited combination of references. “In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be

sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” M.P.E.P. § 2143.01 (8th ed., revised August 2005) at 2100-135 (quoting *In re Linter*, 458 F.2d 1013, 1016 (C.C.P.A. 1972)). To one of ordinary skill in the relevant art, the fluid monitoring reservoir of Manger only would have suggested the use of gases as the monitoring fluid because Manger detects leaks by measuring the pressurization or depressurization of the monitoring fluid. Liquids are well known to the artisan of ordinary skill in this art to be far less compressible than gases; therefore, liquids would be an impractical alternative to gas as a monitoring fluid in Manger’s apparatus. U.S. Patent No. 5,345,813 (“Flessas”), incorporated by reference in Manger, suggest the same conclusion.

The Examiner cites the monitoring liquid reservoir **32** and col. 8, line 64 through col. 9, line 4 of Manger to support the contention that Manger teaches “a monitoring liquid reservoir in liquid communication with the annular space.” Office Action at 3. The teachings of Manger from col. 8, line 54 through col. 9, line 4 are reproduced below:

FIG. 4 further illustrates an optional manifold **32** that may be connected to the test port **24** of the body wall and/or the test port **141** of the fitting **100**. As illustrated in FIG. 4, the manifold **32** may include a manifold test port **40** in fluid
60 communication with both the test port **24** of the body wall **12** and the test port **141** of the fitting **100**. Accordingly, the manifold test port **40** may be in fluid communication with both the interstitial space **22** of the body wall **12** and the interstitial space **160** of the fitting **100** at the same time. An
65 apparatus (not shown) can then be connected to the manifold test port **40** to simultaneously pressurize or depressurize the interstitial spaces **22** and **160** to thereby determine the integrity of both the body wall **12** and the fitting **100**. Since only one test is required for the entire system, the overall testing time and effort required to check the integrity of the dispenser sump apparatus **10** is reduced.

It is clear from this text and from the specification as a whole that Manger suggests pressurization and depressurization of the interstitial fluid to detect leaks. For instance, referring to the text above, the manifold test port **40** is in “fluid communication” the interstitial space **22** (Col. 8, lines 62 – 63), allowing an apparatus to be connected to the test port to pressurize or depressurize the interstitial space (Col. 8, lines 65 – 67) to determine thereby the integrity of the body wall (Col. 8, line 67 through Col. 9, line 1). The purpose of fluid communication, according to Manger, is to test integrity by pressurizing or depressurizing the fluid. *See also* Col. 3, lines 20 – 24 (using pressure to test body wall integrity); Col. 5, lines 27 – 30 (distributing fluid pressure throughout the interstitial space to facilitate testing).

Since liquid is much less compressible than gas, Manger would have suggested to the artisan of ordinary skill that the test fluid should be a gas. Specifically, Manger suggests using gas as the interstitial fluid, for example, at Col. 8, lines 13 – 14, which discusses forming an *airtight* seal between an outer boot **114** and a pipe **148**. Manger further suggests using a gas at Col. 7, lines 54 – 65, which discusses a sealable test port **141**:

A sealable test port **141** of a type well known in the field is disposed on the first section **132** of the inner boot **116** to 55
provide a fluid pathway into the area defined between the
inner and outer boots. The test port **141** may be molded as
part of the inner boot **116** or may be mechanically attached,
for example, by tension or compression thread between the
boot **116** and the test port **141**. The test port **141** may have 60
a threaded portion **142** adapted to connect to a conventional
source of pressurized air. Alternatively, the threaded portion
142 may be connected to a conventional vacuum or under-
pressure source adapted to remove fluid from the fitting
interstitial space **160**. 65

The specification provides that the test port may be adapted to connect to a source of *pressurized air* (lines 61 – 62) or to a *vacuum* or the like (line 63). In either embodiment, the interstitial fluid can only be a gas, not a liquid.

In fact, Manger further *teaches away* from the use of liquid at Col. 6, lines 58 – 59, where he incorporates U.S. Patent No. 5,345,813 (“Flessas”) by reference in its entirety. Flessas says that “prior art devices [*i.e.*, those not possessing the improvements to the containment system offered by the presently claimed invention] . . . could not be tested without filling the containment system with water.” With respect to such prior art devices, Flessas states that pressure testing for leaks is advantageous to water testing:

[v]erifying the integrity of the piping penetrations is crucial to providing a reliable system, and therefore the ability to provide pressure testable piping penetrations is a significant advantage. . . .

Flessas at Col. 1, lines 52 – 56; emphasis added. That is, Flessas suggests using air pressure to facilitate detection of leaks in pipe penetrations into an underground storage device, specifically as an *alternative* to prior art devices that used a liquid, such as water.

Although Manger does not suggest filling the interstitial space with a liquid, the interstitial space of course *could* be filled with a liquid; however, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (8th ed., revised August 2005) at 2100-137 (explaining *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); emphasis in original). In this case, Manger does not suggest the desirability of the proposed modification, and, through the incorporation of Flessas, Manger suggests the opposite. Accordingly, the proposed combination of cited

references does not motive the proposed modification, and the rejection thus is improper and should be withdrawn.

The Examiner combines the teachings of Manger and Berg with those of McGill. Berg does not suggest using a liquid to facilitate leak detection, nor does the Examiner rely on Berg for such a suggestion. *See* Office Action at 4 – 5. McGill does not teach or suggest a monitoring liquid reservoir, where the reservoir is positioned near the top and accessible from a space adjacent the top. McGill instead detects changes in a monitoring liquid level with a high point level sensor **78** located in a dispenser containment sump **18** that is positioned above ground level (McGill at Figure1). McGill does not teach or suggest the advantages achieved by positioning a monitoring liquid reservoir near the top of the underground storage system, where the reservoir is accessible from a space adjacent the top, as presently claimed. For one, the presently claimed monitoring liquid reservoir is easily accessible (Specification at page 3, lines 14 – 15) but less vulnerable to damage because it is underground. For another, the presently claimed reservoir may be positioned so that it is roughly half filled by with liquid from the interstitial space, facilitating detection of movement of liquid in or out of the reservoir. *See, e.g.*, Specification at page 13, lines 4 – 12.

Because the combined references do not teach or suggest the presently claimed invention of claims 1 and 22, particularly an underground storage system comprising a monitoring liquid reservoir in liquid communication with the annular space, where the reservoir is positioned near the top and is accessible from a space adjacent said top, the rejection is improper and should be withdrawn with respect to these claims. Because the

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dependent claims further limit the independent claims, the rejection of the dependent claims likewise is improper and should be withdrawn, as well.

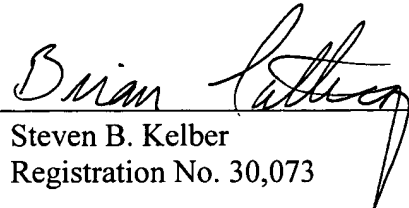
In view of the above remarks, Applicants respectfully request reconsideration and a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.

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